

### REMARKS/ARGUMENTS

The rejections presented in the Office action dated February 18, 2005 have been considered. Claims 1, 3-24, 26-30 and 32-48 are pending in the application. Reconsideration of the pending claims and allowance of the application in view of the present amendment and response is respectfully requested.

Claims 1, 24 and 45-46 stand rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,615,038 to Moles et al. (hereinafter *Moles*). The Applicants respectfully traverse the anticipation rejection.

Referring first to independent Claim 1, the rejection in the current Office Action is analogous to that set forth in the first Office Action (Official Paper No. 9). The Applicants previously responded to the anticipation rejection based on *Moles*, and argued that *Moles* does not teach every element of the claim as required to anticipate a claim. While the same rejection is now made to Claim 1, no response to the Applicants' previous arguments is provided in the current Office Action. The Applicants' maintain the position that *Moles* fails to anticipate Claim 1. More particularly, Applicants' Claim 1 teaches a method of initiating provisioning procedures for terminals operating in a mobile communications network which at least: automatically detects an unprovisioned terminal in the mobile communications network; and provides a notification to a provisioning server to initiate the provisioning procedures for the unprovisioned terminal in response to the automatic detection of the unprovisioned terminal. Thus, in order for the *Moles*' disclosure to anticipate Applicants' Claim 1, *Moles* must teach a provisioning procedure which is automatically triggered after a determination has been made that an unprovisioned terminal exists within the network. Further, *Moles* must also teach that the provisioning procedure has been initiated because an unprovisioned terminal has been detected.

In contrast, however, *Moles* appears to teach that provisioning of mobile terminals is either triggered spontaneously, or in response to a mobile station upgrade request message. (Column 8, lines 48-51). In the case of spontaneously triggered provisioning, *Moles* seems to teach the use of timer 315 in conjunction with scheduling data stored in update schedule file 313 to perform periodic or scheduled mobile station updates. (Column 7, lines 35-47;

Column 7, lines 48-59; and Column 8, lines 14-25). It appears, therefore, that configuration updates taught by *Moles* are not triggered by detection of an unprovisioned mobile terminal, but rather that configuration update software is gathered periodically. Configuration updates may then occur in response to a manual configuration update request sent by the mobile station itself, or periodically as defined by timer 315, update schedule file 313, and associated scheduling data.

Alternately, the Office Action suggests that *Moles* identifies a mobile station as being unprovisioned and then performs a provisioning procedure on the mobile station. (Column 6, lines 27-32). This procedure is discussed in more detail in Column 7, lines 24-28 and lines 60-66, and Column 8, lines 1-13, however, which defines a procedure that is in contrast to Applicants' claimed invention. In particular, *Moles* first teaches that software configuration files are to be requested and subsequently stored within mobile station parameter files 320-350 (see column 7, lines 24-28, and step 425 of FIG. 4) thus beginning the provisioning procedure. Second, mobile station update controller 305 locates one or more mobile stations having a specific manufacturer's identification number or range of hardware revision numbers. (Column 7, lines 60-66, and Column 8, lines 1-4). *Moles*, however, must first request the mobile station's configuration by transmitting a mobile station configuration request message to the mobile station. (Column 8, lines 32-35). Third, if mobile station update controller 305 determines that a manufacturer's identification code of a mobile station matches the manufacturing code associated with the previously stored software configuration files, then a software update to that mobile station is commenced. (Column 8, lines 8-15, and step 430 of FIG. 4). It can be seen, therefore, that the provisioning process of *Moles* is initiated before any mobile stations needing provisioning have been located, since software configuration files are gathered before any mobile stations requiring provisioning have been identified. Further, the provisioning procedure taught by *Moles* is not initiated in response to detecting an unprovisioned mobile station, but is rather initiated periodically according to a predetermined update schedule.

Thus, while *Moles* first locates mobile station software configuration files that may be available from respective mobile station manufacturers, the Applicants' claimed invention instead automatically detects mobile stations that are in need of provisioning.

Further, while *Moles* attempts to match any mobile stations to previously received software configuration files, the Applicants' claimed invention instead issues a notification to a provisioning server to provision the automatically detected unprovisioned mobile terminal. Thus, Applicants respectfully submit that *Moles*' disclosure fails to anticipate Applicants' Claim 1, which is therefore in condition for allowance.

However, in order to facilitate prosecution of the application and in a *bona fide* attempt to move the application to allowance, Claim 1 has been amended. Claim 1 includes the recitations of Claim 2, namely monitoring for a subscriber identifier identifying a particular subscriber and equipment identifier identifying the unprovisioned terminal, and where automatically detecting an unprovisioned terminal includes determining that the subscriber/equipment identifiers do not collectively correspond to known subscriber/equipment affiliations. *Moles* clearly does not teach the invention as set forth in Claim 1 due to at least the aforementioned arguments, as well as due to *Moles*' failure to teach monitoring for a subscriber identifier identifying a particular subscriber and equipment identifier identifying the unprovisioned terminal, and automatic detection of an unprovisioned terminal which includes determining that the subscriber/equipment identifiers do not collectively correspond to known subscriber/equipment affiliations. For at least these reasons, independent Claim 1 is not anticipated by *Moles*.

Because Claim 1 now includes recitations of original Claim 2, and because Claim 2 was rejected as being obvious over *Moles* in view of U.S. Patent No. 5,809,413 to Meche et al. (hereinafter *Meche*), the rejection to Claim 2 is now addressed. In paragraph 8 of the instant Office Action, the Examiner argues that *Moles*, particularly at col. 6, lines 28-33, teaches monitoring for a subscriber identifier identifying a particular subscriber and an equipment identifier identifying the unprovisioned terminal. It is first respectfully submitted that *Moles* is silent with respect to the use of a subscriber identifier and an equipment identifier – rather *Moles* merely identifies that handset data in the HLR identifies a handset as an unprovisioned handset. The recited portion of *Moles* is silent with respect to subscriber and/or equipment identifiers. For at least this reason, the Applicants respectfully submit that *Moles* does not teach what the Office Action purports is taught by *Moles*.

The Examiner notes that *Moles* does not disclose automatic detection of an unprovisioned terminal by determining that the subscriber and equipment identifiers do not collectively correspond to known subscriber and equipment affiliations, but cites *Meche* as teaching this claimed recitation. The Applicants respectfully disagree that *Meche* specifically teaches or suggests this claimed recitation. The Office Action indicates that *Meche* discloses determining that the subscriber and equipment identifiers do not collectively correspond to known subscriber and equipment affiliations, particularly at col. 5, line 22 through col. 8, line 36. It is respectfully submitted that the recited portion of *Meche* does not disclose automatic detection of unprovisioned terminals by determining that subscriber and equipment identifiers do not collectively correspond to known subscriber and equipment affiliations, as proffered by the Examiner.

More particularly, *Meche* relates to disabling the use of a user identity module (UIM) to prevent unauthorized use of the UIM (see, e.g., Abstract). *Meche* generally describes that a particular mobile can be locked to a certain UIM, so that the mobile device cannot be used with other UIMs than the one it is locked to. (see col. 2, lines 1-9). The disclosure of *Meche* generally relates to a security feature, and does not disclose automatic detection of unprovisioned terminals by determining that subscriber and equipment identifiers do not collectively correspond to known subscriber and equipment affiliations as suggested by the Examiner. The process of *Meche* takes place in the terminal, and the network monitors the list of the terminals. *Meche* is silent with respect to provisioning, and therefore does not, as suggested in the Office Action, teach automatically detecting unprovisioned terminals by determining that subscriber and equipment identifiers do not collectively correspond to known subscriber and equipment affiliations.

Further, Claim 1 involves determining whether the subscriber and equipment identifiers *collectively* correspond to known subscriber/equipment affiliations, and *Meche* does not teach determining whether this subscriber/equipment identifier group corresponds to known subscriber/equipment identifier groups. Rather, *Meche* appears to involve associating a device with a particular UIM, and does not teach or suggest comparing the collective association of subscriber/equipment identifiers with known, collective associations of such identifiers.

To establish a *prima facie* case of obviousness, three basic criteria must be met, one of which is that the combined prior art references must teach or suggest all the claim limitations. (M.P.E.P. §2142). Even if combined, the combination of *Moles* and *Meche* fails to teach or suggest at least the aforementioned claimed features. For example, a combination of *Moles* and *Meche* fails to teach or suggest providing a notification to initiate provisioning procedures *in response to* an automatic detection of the unprovisioned terminal. As described above, contrary to what is proffered in the Office Action, *Moles* does not teach this aspect of the claimed invention, and *Meche* further fails to teach this claimed recitation. Therefore a combination of *Moles* and *Meche* fails to teach all of the claim limitations. Further, a combination of *Moles* and *Meche* fails to teach or suggest automatically detecting unprovisioned terminals by determining that subscriber and equipment identifiers do not collectively correspond to known subscriber and equipment affiliations, as set forth above. For at least these reasons, it is respectfully submitted that a combination of *Moles* and *Meche* fails to teach or suggest all of the claim limitations of Claim 1, *prima facie* obviousness has not been met, and Claim 1 is not rendered obvious by the combination of *Moles* and *Meche*.

Another requirement to establish a *prima facie* case of obviousness is that there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. The Applicants respectfully submit that this burden has not been met in the Office Action. The Applicants first contend that the Examiner has not established the requisite motivation to combine *Moles* and *Meche*, and second that there is no such motivation. In the obviousness rejection to Claim 2 (now corresponding to amended Claim 1), the Office Action sets forth a motivation to combine *Moles* and *Meche* as being that one of ordinary skill in the art would add the security feature of *Meche* to *Moles* **"for enhanced security in the wireless communication system."** The Applicants contest the proffered motivation to combine *Moles* and *Meche* on at least the ground that 1) the proffered motivation is merely a general statement of "enhancement" in the wireless communication system and fails to provide the clear and particular evidence of a suggestion

or motivation to combine prior art references; and 2) the broad statement deals with *security*, which is inapplicable to Claim 1.

More particularly, to establish *prima facie* obviousness, the proffered motivation must provide a clear and particular showing, supported by actual evidence, to combine the references. *Teleflex, Inc. v. Ficosa North America Corp.*, 299 F.3d 1313, 1334, 63 U.S.P.Q.2d 1374, 1387 (Fed. Cir. 2002). It is respectfully submitted that the reason “for enhanced security in the wireless communication system” does not rise to the level of clear and particular actual evidence. For at least this reason, it is respectfully submitted that the requisite showing of motivation to combine *Moles* and *Meche* has not been met. Further, “enhanced security” does not relate to *Moles*, and would not provide a reason to combine *Meche* with *Moles*. For at least these reasons, it is respectfully submitted that *prima facie* obviousness is not established for lack of motivation to combine *Moles* and *Meche*.

Due to the failure of the combined references to teach or suggest all of the claim limitations, and because the requisite motivation to combine *Moles* and *Meche* has not been established, *prima facie* obviousness has not been established, and Claim 1 as pending is allowable over the cited combination of references. Reconsideration and allowance of Claim 1 is respectfully requested.

Dependent Claim 24, which is dependent from independent Claim 1, also stands rejected as being anticipated by *Moles*. While Applicants do not acquiesce with any particular rejections to dependent Claim 24, it is believed that this rejection is moot in view of the remarks made in connection with independent Claim 1. This dependent claim includes all of the limitations of Claim 1 as amended, and recites additional features which further distinguish these claims from the cited references. Therefore, dependent Claim 24 is also allowable over *Moles*, or in the alternative, over the combination of *Moles* and *Meche*.

Independent Claim 45 also stands rejected as being anticipated by *Moles*. The Applicant respectfully submits that the anticipation rejection to Claim 45 is erroneous, as Claim 45 is dependent from independent Claim 28 which has been rejected as being obvious over the combination of *Moles* and *Meche*. Because the obviousness rejection of Claim 28 recognizes that *Moles* fails to teach all of the claimed recitations of Claim 28, Claim 45 cannot be anticipated by *Moles*.

Independent Claim 46 stands rejected as being anticipated by *Moles* for the same reasons set forth in the Office Action relating to independent Claim 1. Analogous to that of Claim 1, Claim 46 has been amended to facilitate prosecution of the application. Amended Claim 46 is not anticipated by *Moles*, nor is amended Claim 46 rendered obvious by a combination of *Moles* and *Meche* (see arguments above). For these reasons, Claim 46 is in condition for allowance.

Claims 2-4, 7-11, 19-22, 28-29, and 47 stand rejected under 35 U.S.C. §103(a) as being unpatentable over *Moles* in view of *Meche*. Of these claims, Claims 28 and 47 are independent claims. Claim 2 has been canceled and therefore the rejection to Claim 2 is moot. However, as previously described, Claim 1 has been amended to incorporate features of original dependent Claim 2. Applicants previous remarks commented on the obviousness rejection as it applies to amended Claim 1, and as set forth above the Applicants contend that Claim 1 is not rendered obvious over the combination of *Moles* and *Meche*.

Dependent Claims 3-4, 7-11 and 19-22, which are dependent from amended Claim 1, were also rejected under 35 U.S.C. §103(a) as being unpatentable over the combination of *Moles* and *Meche*. While Applicants do not acquiesce with any particular rejections to these dependent claims, it is believed that these rejections are now moot in view of the amendments and remarks made in connection with independent Claim 1. These dependent claims include all of the limitations of the base claim and any intervening claims, and recite additional features which further distinguish these claims from the cited references. "If an independent claim is nonobvious under 35 U.S.C. §103, then any claim depending therefrom is nonobvious." M.P.E.P. §2143.03; citing *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). Therefore, dependent Claims 3-4, 7-11 and 19-22 are also allowable over the combination of *Moles* and *Meche*.

Regarding Claim 28, the Applicants have amended Claim 28 to facilitate prosecution of the application. Claim 28 includes a network element capable of receiving subscriber and equipment identifiers, and incorporates features of Claim 31 which was rejected as being obvious over the combination of *Moles* and *Raith*. The Applicants submit that Claim 28 is not rendered obvious by the combination of *Moles* and *Raith*. The

Examiner acknowledges that *Moles* does not disclose comparing the affiliated identifier pair to the stored identifier pairs at a network element, but contends that *Raith* teaches this, particularly at col. 2, lines 40-42. The Applicants respectfully disagree. For example, the cited portion of *Raith* describes comparing an electronic serial number (ESN) to a list of ESNs of stolen mobile stations. There are no subscriber/equipment identifier pairs disclosed in either *Moles* or *Raith*, and a combination of *Moles* and *Raith* thereby fails to teach or suggest comparing such groups to known identifier pairs. For at least this reason, *prima facie* obviousness is not established, because all of the claim limitations of Claim 28 are not taught or suggested by the combined references.

Further, establishing *prima facie* obviousness requires that there is some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. The Applicants respectfully submit that this burden has not been met. *Raith* does not relate to device provisioning, but rather deals with a manner of transmitting information on a communications channel. In the rejection of Claim 31 (now generally incorporated into Claim 28), the Examiner indicates that the motivation to combine *Raith* with *Moles* is "for faster response." The Applicants respectfully submit that this proffered motivation to combine *Raith* with *Moles* does not rise to the level of clear, particular and actual evidence required to establish the proper motivation to combine references. For at least this additional reason, the Applicants respectfully submit that Claim 28 is allowable over the cited combination of references. Similarly, independent Claim 47 has been amended, and is in condition for allowance for at least the reasons set forth in connection with the remarks to Claim 28.

Due to the failure of the combined references to teach or suggest all of the claim limitations, and because there is no motivation to combine the cited references, Claims 28 and 47 are in condition for allowance. Reconsideration and allowance of Claims 28 and 47 is respectfully requested.

Dependent Claim 29 is dependent from independent Claim 28. While Applicant does not acquiesce with any particular rejections to dependent Claim 29, Claim 29 includes all of the limitations of Claim 28, and recites additional features which further distinguish it



from the cited references. Therefore, dependent Claim 29 is also in condition for allowance.

Claims 12-13 stand rejected under 35 U.S.C. §103(a) as being unpatentable over *Moles* in view of *Meche* and in further view of U.S. Patent No. 5,365,572 to Saegusa et al (hereinafter *Saegusa*). Claims 12-13 are dependent on independent Claim 1, and as set forth above, the combination of *Moles* and *Meche* fail to teach all the elements of Claim 1. *Saegusa* fails to remedy the deficiencies of the combination of *Moles* and *Meche*, and thus the combination of *Moles*, *Meche* and *Saegusa* fails to teach or suggest all the limitations of Claim 1. Claims 12-13 are dependent from and include all the limitations of independent Claim 1, and therefore are in condition for allowance. Further, *Saegusa* relates to establishing connections for cordless telephones, and does not relate to provisioning. The Applicants respectfully submit that there is no motivation to combine *Saegusa* with *Moles*, in addition to the lack of motivation to combine *Moles* and *Meche*. For this additional reason, it is respectfully submitted that *prima facie* obviousness is not established for Claims 12-13, and these claims are allowable over the cited prior art.

Claims 15-17 stand rejected under 35 U.S.C. §103(a) as being unpatentable over *Moles* in view of *Meche* and in further view of U.S. Patent No. 6,658,231 to *Nakatsuyama*. Claims 15-17 are dependent on independent Claim 1, and as set forth above, the combination of *Moles* and *Meche* fail to teach all the elements of Claim 1. *Nakatsuyama* fails to remedy the deficiencies of the combination of *Moles* and *Meche*, and thus the combination of *Moles*, *Meche* and *Nakatsuyama* fails to teach or suggest all the limitations of Claim 1. Claims 15-17 are dependent from and include all the limitations of independent Claim 1 and any intervening claims, and therefore are in condition for allowance. Further, *Nakatsuyama* does not relate to provisioning, and the Applicants respectfully submit that there is no motivation to combine *Nakatsuyama* with *Moles*, in addition to the lack of motivation to combine *Moles* and *Meche*. For this additional reason, it is respectfully submitted that *prima facie* obviousness is not established for Claims 15-17, and these claims are allowable over the cited prior art.

Claim 26 stands rejected under 35 U.S.C. §103(a) as being unpatentable over *Moles* in view of *Meche* and in further view of U.S. Patent No. 6,757,544 to Rangarajan et al.

(hereinafter *Rangarajan*). Claim 26 is dependent from independent Claim 1, and as set forth above, the combination of *Moles* and *Meche* fail to teach all the elements of Claim 1. *Rangarajan* fails to remedy the deficiencies of the combination of *Moles* and *Meche*, and thus the combination of *Moles*, *Meche* and *Rangarajan* fails to teach or suggest all the limitations of Claim 1. Claim 26 is dependent from and includes all the limitations of independent Claim 1 and any intervening claims, and therefore is in condition for allowance. Further, *Rangarajan* relates to determining locations of users, and does not relate to provisioning. The Applicants respectfully submit that there is no motivation to combine *Rangarajan* with *Moles*, in addition to the lack of motivation to combine *Moles* and *Meche*. For this additional reason, it is respectfully submitted that *prima facie* obviousness is not established for Claim 26, and this claim is allowable over the cited prior art.

Claim 27 stands rejected under 35 U.S.C. §103(a) as being unpatentable over *Moles* in view of *Meche* and in further view of U.S. Patent No. 6,839,564 to Sutinen et al. (hereinafter *Sutinen*). Claim 27 is dependent from independent Claim 1, and as set forth above, the combination of *Moles* and *Meche* fail to teach all the elements of Claim 1. *Sutinen* fails to remedy the deficiencies of the combination of *Moles* and *Meche*, and thus the combination of *Moles*, *Meche* and *Sutinen* fails to teach or suggest all the limitations of Claim 1. Claim 27 is dependent from and includes all the limitations of independent Claim 1 and any intervening claims, and therefore is in condition for allowance. Further, *Sutinen* relates to synchronizing database information, and does not relate to provisioning. The Applicants respectfully submit that there is no motivation to combine *Saegusa* with *Moles*, in addition to the lack of motivation to combine *Moles* and *Meche*. For this additional reason, it is respectfully submitted that *prima facie* obviousness is not established for Claim 27, and this claim is allowable over the cited prior art.

Claims 5, 30-34, and 36 stand rejected under 35 U.S.C. §103(a) as being unpatentable over *Moles* in view of U.S. Patent No. 5,404,355 to *Raith*. Claim 30 is dependent from Claim 28, which as set forth above is in condition for allowance. Thus, Claim 30 is in condition for allowance, as it includes all the limitations of the base claim and any intervening claims. Claim 31 has been canceled and the rejection to this claim is

therefore moot. The combination of *Moles* and *Raith* has been addressed above with respect to independent Claim 28, and Claim 28 is allowable over a combination of *Moles* and *Raith*. Claims 32-34 and 36 are dependent from independent Claim 28 and include all the limitations of Claim 28 and any intervening claims, and therefore are also in condition for allowance.

Claim 5 is dependent from Claim 1, which as previously argued is not anticipated by *Moles*. *Raith* does not remedy the deficiencies of *Moles* as it applies to amended Claim 1, and therefore Claim 1 is allowable over *Moles* and *Raith*, thereby making each claim dependent from independent Claim 1 allowable over the cited combination of references. Further, *Raith* does not relate to device provisioning, but rather deals with a manner of transmitting information on a communications channel. In the rejection of Claim 5, the proffered motivation to combine *Raith* with *Moles* is "for faster response." The Applicants respectfully submit that this proffered motivation to combine *Raith* with *Moles* does not rise to the level of clear, particular and actual evidence required to establish the proper motivation to combine references. For at least this additional reason, the Applicants respectfully submit that Claim 5 is allowable over the cited combination of references.

Claims 6, 38-41, and 43 stand rejected under 35 U.S.C. §103(a) as being unpatentable over *Moles* in view of U.S. Patent No. 6,636,502 to Lager et al. (hereinafter *Lager*). Claim 6 is dependent from independent Claim 1, and as set forth above, the combination of *Moles* and *Meche* fail to teach or suggest all the elements of Claim 1. *Lager* fails to remedy the deficiencies of *Moles* or a combination of *Moles* and *Meche*, and thus the combination of *Moles* and *Lager*, or of *Moles*, *Meche* and *Lager*, fails to teach or suggest all the limitations of Claim 1. Claim 6 is dependent from and includes all the limitations of independent Claim 1 and any intervening claims, and therefore is in condition for allowance. Further, *Lager* does not relate to provisioning. The Applicants respectfully submit that there is no motivation to combine *Lager* with *Moles*. It is also noted that the proffered motivation to combine *Lager* with *Moles*, stated as "faster response," does not provide the clear and particular evidence required to establish motivation to combine. Further, it is unclear as to what response is faster. For these additional reasons, it is respectfully submitted that *prima facie* obviousness is not established for Claim 6, and this

claim is allowable over the cited prior art. The same applies for dependent Claims 38-41 and 43, which are dependent from amended Claim 28, and therefore Claims 38-41 and 43 are in condition for allowance.

Claim 14 stands rejected under 35 U.S.C. §103(a) as being unpatentable over *Moles* in view of *Meche* and in further view of U.S. Patent No. 6,282,421 to Chatterjee et al. (hereinafter *Chatterjee*). Claim 14 is dependent from independent Claim 1, and as set forth above the combination of *Moles* and *Meche* fail to teach all the elements of Claim 1. *Chatterjee* fails to remedy the deficiencies of the combination of *Moles* and *Meche*, and thus the combination of *Moles*, *Meche* and *Chatterjee* fails to teach or suggest all the limitations of Claim 1. Claim 14 is dependent from and includes all the limitations of independent Claim 1 and any intervening claims, and therefore is in condition for allowance.

Claims 18 and 35 stand rejected under 35 U.S.C. §103(a) as being unpatentable over *Moles* in view of *Meche* and in further view of U.S. Patent No. 6,519,468 to Donovan et al. (hereinafter *Donovan*). Claims 18 and 35 are dependent from independent Claims 1 and 28 respectively, and as set forth above the combination of *Moles* and *Meche* fails to teach all the elements of Claims 1 and 28. *Donovan* fails to remedy the deficiencies of the combination of *Moles* and *Meche*, and thus the combination of *Moles*, *Meche* and *Donovan* fails to teach or suggest all the limitations of Claim 1. Claims 18 and 35 are respectively dependent from and include all the limitations of independent Claims 1 and 28 and any intervening claims, and therefore are in condition for allowance. Further, *Donovan* merely relates to SMS services, and does not relate to provisioning. The Applicants respectfully submit that there is no motivation to combine *Donovan* with *Moles*, in addition to the lack of motivation to combine *Moles* and *Meche*. For this additional reason, it is respectfully submitted that *prima facie* obviousness is not established for Claims 18 and 35, and these claims are allowable over the cited prior art.

Claim 23 stands rejected under 35 U.S.C. §103(a) as being unpatentable over *Moles* in view of *Meche* and in further view of U.S. Patent No. 5,819,177 to Vucetic et al. (hereinafter *Vucetic*). Claim 23 is dependent from independent Claim 1, and as set forth above the combination of *Moles* and *Meche* fail to teach all the elements of Claim 1.

*Vucetic* fails to remedy the deficiencies of the combination of *Moles* and *Meche*, and thus the combination of *Moles*, *Meche* and *Vucetic* fails to teach or suggest all the limitations of Claim 1. Claim 23 is dependent from and includes all the limitations of independent Claim 1 and any intervening claims, and therefore is in condition for allowance. Further, the cited portion of *Vucetic* refers to the generation of an alarm by the wireless terminal. The alarm is unrelated to provisioning, and the wireless terminal (not an NMS) generates the alarm. Therefore a combination of these three references does not teach all of the claim limitations. Additionally, *Vucetic* does not relate to provisioning, and therefore there is no motivation to combine *Vucetic* with *Moles*. For these additional reasons, Claim 23 is not rendered obvious by the combination of *Moles*, *Meche* and *Vucetic*.

Claim 37 stands rejected under 35 U.S.C. §103(a) as being unpatentable over *Moles* in view of *Raith* and in further view of *Vucetic*. As previously remarked, *Moles* and *Raith* fail to teach all the claim limitations of independent Claim 28, from which Claim 37 is dependent from. *Vucetic* does not remedy the deficiencies of *Moles* and *Raith*. Because Claim 37 is dependent from Claim 28, Claim 37 is also not rendered obvious by the combination of references. Further, *Vucetic* refers to the generation of an alarm by the wireless terminal. The alarm is unrelated to provisioning, and the wireless terminal (not an NMS) generates the alarm. Therefore a combination of these three references does not teach all of the claim limitations. Additionally, *Vucetic* does not relate to provisioning, and therefore there is no motivation to combine *Vucetic* with *Moles*. For these additional reasons, Claim 23 is not rendered obvious by the combination of *Moles*, *Raith* and *Vucetic*.

Claims 42 and 44 stand rejected under 35 U.S.C. §103(a) as being unpatentable over *Moles* in view of *Lager* and in further view of *Donovan*. Claims 42 and 44 are dependent from Claim 41, which is dependent from Claim 38, which in turn is dependent from independent Claim 28. As previously remarked, neither *Moles*, nor a combination of *Moles* and *Meche* teaches the limitations of Claim 28. Neither *Lager* nor *Donovan* remedy these deficiencies. Importantly, there is no motivation to combine these references. The Applicants respectfully submit that the Examiner has pieced together aspects purportedly found in the prior art to arrive at the invention through hindsight. As stated by the Federal Circuit, combining prior art references without evidence of such a suggestion, teaching or

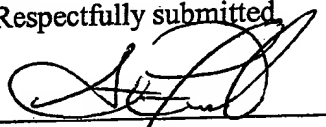
motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability, which is the essence of hindsight. *In re Dembiczak*, 50 USPQ2d 1614, (Fed. Cir. 1999) (citing *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1138, 227 USPQ 543, 547 (Fed. Cir. 1985); emphasis added). For at least these reasons, *prima facie* obviousness is not established for Claims 42 and 44, and these claims are allowable over the cited combination of references.

New claim 48 is directed to a network element that facilitates provisioning of terminals in a mobile communications network. This particular network element includes a detection module that monitors for subscriber and equipment identifiers, and identifies unprovisioned terminals based on correspondence between the subscriber and equipment identifiers and any of a plurality of known subscriber and equipment affiliations. The network element also includes a provisioning trigger module to generate provisioning notifications for unprovisioned terminals identified by the detection module. The Applicants respectfully submit that Claim 48 is allowable over the cited prior art.

### CONCLUSION

The Applicants respectfully submit that the application is in condition for allowance. If the Examiner believes it helpful, the undersigned attorney of record invites the Examiner to contact him at 952-854-2700 (x11) to discuss any issues related to this case.

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